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CANON U.S.A. INC. INTELLECTUAL PROPERTY DIVISION
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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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3621

NOTIFICATION DATE	DELIVERY MODE
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10/02/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/735,108	Applicant(s) MATSUDA ET AL.	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22,27,29-32 and 39-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22,27,29-32 and 39-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20090921 for reference purposes only.
2. This Office Action is in response to the Request for Continued Examination, filed on 16 July 2009.
3. All references to the capitalized version of “Applicant” refer specifically to the Applicant or Applicants of record in the instant application. Any references to lowercase versions of “applicant” or “applicants” refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. Claims 22, 27, 29-32, 37, and 39-42 are pending.
5. Claims 22, 27, 29-32, 37, and 39-42 have been examined.

Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 July 2009 has been entered.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 22, 30-32, and 40-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent 5,974,150 ("Kaish") in view of Microsoft Computer Dictionary ("Microsoft"), further in view of United States Patent 6,269,169 ("Funk").

9. As per claims 22, 32, and 42, Kaish discloses:

10. database programmed to store registered trademark image information (figure 1, reference 5) and genuine-product-specific information corresponding to the product name (figure 1, reference 3, 4);

11. input unit configured that inputs product data acquired by scanning a product (figure 2, reference 35-39, 41);

12. determining unit configured that determines that the product is a genuine product when the determining unit determines that the product data input by the input unit includes the registered trademark information and the genuine-product-specific information in the database corresponding to the product name input in the input screen (column 9, lines 12-22; column 10, line 57 - column 11, line 2 - "unique, random, or quasi-unique characteristic of the item is encoded on the label"; column 27, lines 20-30 - "sheet of material...code number...manufacturing information, such as serial number, date, location, lot number, copyright notice");

13. determines that the product is a counterfeit product when the determining unit determines that the product data input by the input unit includes the registered trademark image information in the database corresponding to the product name input in the input screen (column 27, lines 20-30 - "fiber pattern, which is random (irregular), is illuminated..."; column 28, lines 7-30 - "medium is then scanned, and an analogous vector mapping derived from the newly scanned image. The recorded vector map is compared with the measured vector map...");
14. notification unit programmed to notify that the product is a genuine product when the product is determined to be a genuine product by the determining unit (column 26, lines 28-48 - "outputs an indication of the authentication 117"); and
15. to notify that the product is a counterfeit product when the product is determined to be a counterfeit product by the determining unit (column 26, lines 28-48 - "outputs an indication of the authentication 117...security routines are executed 112...").
16. Kaish does not explicitly disclose:
17. providing unit configured that provides an input screen for inputting a product name;
18. Microsoft teaches:
19. providing unit configured that provides an input screen for inputting a product name (Page 524, "touch screen...designed or modified to recognize the location of a touch on its surface").
20. Kaish, in column 17, lines 11-15, recites "manually or automatically verifies the printed code on the label". One such method of "automatically" verifying the printed code on the label is

through Optical Character Recognition ("OCR")¹. One alternative to scanning data is to manually type the text data printed on the paper, using such items as a keyboard or a "touch screen" (defined by Microsoft as a "computer screen designed or modified to recognize the location of a touch on its surface" (page 524), enabling a human user to enter data as he would on a keyboard or any other device).

21. The difference between the reference and the instant application is that the reference does not disclose entering data manually using a touch screen, in place of scanning the data using a scanner. Since each individual system of entering data into a computer and its function are shown in the prior art (though in different references), the difference between the claimed subject matter and the prior art rests not on an individual element or function, but the combination itself – that is, in the substitution of a touch screen in Kaish. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a touch screen in place of scanning the product information, because the simple substitution of one known element for another, producing a predictable result, renders the claim obvious. A person having ordinary skill in the art would see the substitution as advantageous, because it would allow for a backup method of entering important data.

22. Neither Kaish nor Microsoft explicitly disclose:

¹ Microsoft discloses that OCR operates by "[examining] printed characters on paper and [determining] their shapes by detecting patters of dark and light" (page 379).

23. determine that the product is a third party product when the determining unit determines that the product data input by the input unit does not include the registered trademark image information in the database corresponding to the product name input in the input screen;

24. notifying that the product is a third party product when the product is determined to be a third party product.

25. Funk teaches:

26. determine that the product is a third party product when the determining unit determines that the product data input by the input unit does not include the registered trademark image information in the database corresponding to the product name input in the input screen (figure 4, reference 60, 38);

27. notifying that the product is a third party product when the product is determined to be a third party product (figure 4c, reference 39).

28. Funk does this to distinguish between documents that are genuine (i.e. whose “doc type” is in the library, figure 4, reference 60; and whose anti-counterfeit features check out, figure 4a, reference 47-50), documents that are counterfeit (i.e. whose “doc type” is in the library, figure 4a, reference 47-50; and whose anti-counterfeit features do not pass the test, figure 4a, reference 46), and documents that are neither genuine nor counterfeit, but are not part of the system (i.e. whose “doc type” is not in the system, figure 4, reference F; figure 4c, reference 39-42). This enables a system that distinguishes between genuine documents, counterfeit documents, and documents whose veracity cannot be determined by the system, because either their manufacturer, or the document itself, is not part of the system. A person having ordinary skill in

the art would see this as advantageous because it would create a more secure environment for articles that could be counterfeit, but would not generate false positives.

29. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Kaish the system of identifying third-party documents as taught by Funk, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more secure environment for articles that could be counterfeit, but would not generate false positives.

30. As per claims 30 and 40, Kaish in view of Microsoft, further in view of Funk, discloses as above, and further discloses:

31. product includes toner for a printer (the Examiner contends that this is an intended use of the invention, as such, it is not given patentable weight. Furthermore, there is nothing preventing the system in Kaish from being used as a printer toner counterfeit detection system, instead noting that “electronics and software products are also particular targets of counterfeiters” (column 1, lines 53-56)).

32. As per claims 31 and 41, Kaish in view of Microsoft, further in view of Funk, discloses as above, and further discloses:

33. storing determination result (figure 2, reference numbers 20, 24; figure 3, reference numbers 45, 48, 55; figure 4a, reference numbers 106, 107).

34. Claims 27, 29, 37, and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kaish in view of Microsoft, further in view of Funk, further in view of Admitted Prior Art.

35. As claims 27, 29, 37, and 39 are best understood by the Examiner, Kaish in view of Microsoft, further in view of Funk, discloses as above, but does not explicitly disclose:

36. information is written in a micro-character.

37. It is now Admitted Prior Art (under MPEP §2144.03(c)) that using micro-characters for providing a higher lever of visual security was well known to those skilled in the art at the time of the invention. These characters were well known to those skilled in the art at the time of the invention to provide an easily-authenticated system of physical objects. Due to the desire to easily authenticate items using micro-characters being well known to those skilled in the art at the time of the invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use micro-characters in conjunction with the system in Kaish, to give a higher degree of security. A person having ordinary skill in the art would understand that the usage of micro-characters would be advantageous, since it provides for a more easily-authenticated system that is harder to forge.

38. Kaish in view of Microsoft, further in view of Funk, discloses as above, but does not explicitly disclose:

39. programmed to notify another terminal of a determination result obtained by the determining unit.

40. There is a desire in the system in Kaish to provide a secure method of authenticating products – evidence exists in column 26, lines 33 – 36. Clearly there is a desire for security, and sending along the authenticated user information would allow for a higher degree of security in the system. It is now Admitted Prior Art (under MPEP §2144.03(c)) that user information is transmitted to the remote site. Additionally, it was obvious to one skilled in the art at the time of the invention to send usernames with secure communication, in order to authenticate transactions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the user information to the remote site, in order to provide a higher level of security. A person having ordinary skill in the art would understand this to be advantageous, as it provides more security.

41. Kaish in view of Microsoft, further in view of Funk, discloses as above, but does not explicitly disclose:

42. when the unit determines that a product is a counterfeit product, the unit notifies a counterfeit product's regulatory authority terminal of the determination result.

43. It is now Admitted Prior Art (under MPEP §2144.03(c)) that notifying a regulatory authority of counterfeit products was old and well-known in the art because this is how most regulatory authorities receive information on such products, by self-reporting of individuals receiving counterfeit items. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kaish to send information to a regulatory authority of the counterfeit nature of the scanned product, because it would enable a more informative and

helpful (in stemming the problem of counterfeiting) system, something that a person having ordinary skill in the art would see as advantageous.

Response to Arguments

44. Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground of rejection. Furthermore, they argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

45. Applicants' disputing of "the Examiner's assertion in the Official Notice [from the Office Action dated 23 July 2009] that it is old and well known in the art that human beings would not confuse two separate parts" (remarks, page 12, ¶2) has been considered but is unconvincing. The Examiner finds that a normal human being, or a person having low skill in the art, would be able to distinguish between two products that are clearly not of the same brand.

46. For example, a person having even low skill in the art would not confuse the “Starbucks Coffee” logo:



47.

48. with the logo for “Dunkin' Donuts”:



49.

50. (Trademark serial numbers 78567740 and 76266478, respectively, record from Trademark Database “TESS” included for Applicants’ convenience).

51. As these are both examples of “trademark image information”, and a person having low skill in the art would be able to distinguish between both of them, the contention that a human being would be able to perform such a comparison is a contention “capable of such instant and unquestionable demonstration as to defy dispute” (MPEP §2144.03 A). The Examiner finds that a human being who wishes to determine whether a product is made by Starbucks would not reasonably infer that a product marked with the “Dunkin’ Donuts” logo (as above) were made by Starbucks. Furthermore, the Examiner finds that a person seeing the “Dunkin’ Donuts” logo would not attempt to look for information that would genuinely identify a Starbucks logo (e.g. “micro-character”), since he would not expect it to be present.

52. As such, the Examiner has provided “documentary evidence of the factual assertions...made in the Official Notice” (remarks, page 11, ¶3). In accordance with *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958), the Examiner finds that it would have been obvious to provide an automatic mechanism for performing these tasks. See argumentation in Paper Number 20090715, paragraphs 21-24.

53. Applicants' arguments concerning this feature are therefore unconvincing.

54. Applicants further interpret the Examiner's arguments as arguing that “the ability to distinguish between whether a part is counterfeit vs. from a third party is not of concern to those of ordinary skill in the art” (remarks, page 12, ¶1). The Examiner cannot find where such a contention was made; it is merely clear that the determination between a third-party product (made by a third party, attempting to look like a third party's product) and a counterfeit product (made by a second party, attempting to look like a first party's product) is within the skill of a person having even low skill in the art.

Conclusion

55. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. United States Patent Application Publication 2001/0006556 (Graves et al), drawn to a system for distinguishing between genuine, suspect, and “no call” (neither genuine nor counterfeit; likely a third-party document) documents;

b. United States Patent 5,592,561 (Moore), drawn to an anti-counterfeiting system, whereby two marks are embedded into fabric - a “goods identifier” and a “manufacturer identifier”.

56. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

57. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

58. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621